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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,610	08/24/2001	Huiping Li	37112-173148	8980
Venable P.O. Box 34385 Washington, DC 20043-9998			EXAMINER BRIER, JEFFERY A	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 12/03/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/935,610

**Applicant(s)**

LI ET AL.

**Examiner**

Jeffery A. Brier

**Art Unit**

2628

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No./Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/2008 has been entered.

### ***Response to Amendment***

2. The amendment filed on 10/16/2008 has been entered.

3. The amendment filed 10/16/2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The deletion in paragraph [0014] in the 10/16/2008 amendment is new matter since it changes the scope of the specification's computer-readable medium

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The objection to the specification set forth in paragraph 3 of the office action mailed on 06/16/2008 is withdrawn since in order to change this paragraph the meaning applicant has given to computer-readable medium would be changed. Thus, claim 26 continues to claim signals.

5. The indication of allowability in paragraph 7 of the office action mailed on 06/16/2008 is withdrawn in view of recently decided *In re Bilski*. In *re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

### ***Response to Arguments***

6. Applicant's arguments concerning the 35 USC 101 rejection filed 10/16/2008 have been fully considered but they are not persuasive in view of recently decided *In re Bilski*. In *re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Many of applicants claim terms are defined in the specification as follows:

Video is defined in paragraph [0018] as:

"Video" refers to motion pictures represented in analog and/or digital form. Examples of video include television, movies, image sequences from a camera or other observer, and computer-generated image sequences. These can be obtained from, for example, a live feed, a storage device, a firewire interface, a video digitizer, a computer graphics engine, or a network connection.

Computer is defined in paragraph [0013] as:

A "computer" refers to any apparatus that is capable of accepting a structured input, processing the structured input according to prescribed rules, and producing results of the processing as output. Examples of a computer include: a computer; a general purpose computer; a supercomputer; a mainframe; a super mini-computer; a mini-computer; a workstation; a microcomputer; a server; an interactive television; a hybrid combination of a computer and an interactive television; and application-specific hardware to emulate a computer and/or software. A computer can have a single processor or multiple processors, which can operate in parallel and/or not in parallel. A computer also refers to two or more computers connected together via a network for transmitting or receiving information between the computers. An example of such a computer includes a distributed computer system for processing information via computers linked by a network.

Computer system is defined in paragraph [0016] as:

A "computer system" refers to a system having a computer, where the computer comprises a computer-readable medium embodying software to operate the computer.

Video apparatus is not defined in the specification nor in the originally filed claims and currently pending claims 26-28 define the video apparatus as a computer, thus, the claimed video apparatus is an open ended term and is not a specific machine. Independent claims 1, 4, 26-29, 31, and 35 cover extracting any preexisting image in any type of image since each independent claim claims "static graphics only overlay or graphics overlay including text" (claims 1 and 35) or "text only overlay" (claims 4, 29 and 31) which taken in the whole covers: static graphics only overlay and graphics overlay including text and text only overlay. Thus, these claims cover extracting any preexisting image in any type of image without claiming a physical transformation or a specific machine, thus, these claims preempt all substantial uses of the claimed abstract idea or mathematical algorithm. Additionally In re Bilski discusses In re Able and in view of Able the apparatus or computer of these claims do not make the method statutory since at page 688 of Able an apparatus claim 7 was held non-statutory for the same reason given for method claim 5. In re Able and Marshall, 214 USPQ 682 (C.C.P.A. 1982).

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Method claims 1-25 and 29-38:

These claims claim an abstract idea or mathematical algorithm without claiming a physical transformation or a specific machine. In re Bilski, 88 USPQ2d 1385 (Fed. Cir. 2008). The claimed video processing apparatus is not defined by the specification, thus, video processing apparatus covers all apparatus and software for performing the claimed abstract steps or mathematical steps. Video apparatus is not defined in the specification nor in the originally filed claims and currently pending claims 26-28 define the video apparatus as a computer, thus, the claimed video apparatus is an open ended term and is not a specific machine. Independent claims 1, 4, 26-29, 31, and 35 cover extracting any preexisting image in any type of image since each independent claim claims "static graphics only overlay or graphics overlay including text" (claims 1 and 35) or "text only overlay" (claims 4, 29, and 31) which taken in the whole covers: static graphics only overlay and graphics overlay including text and text only overlay. Thus, these claims cover extracting any preexisting image in any type of image without claiming a physical transformation or a specific machine, thus, these claims preempt all substantial uses of the claimed abstract idea or mathematical algorithm. Additionally In re Bilski discusses In re Able and in view of Abele the apparatus or computer of these

claims do not make the method statutory since at page 688 of Abele an apparatus claim 7 was held non-statutory for the same reason given for method claim 5. In re Abele and Marshall, 214 USPQ 682 (C.C.P.A. 1982). In essence these claims preempt the use of the claimed abstract idea or mathematical algorithm.

Computer-readable medium claim 26:

In view of applicants specification at paragraph [0014] the claimed computer-readable medium is any medium which stores the computer-executable code, including signals. Signals were found to be non-statutory in In re Nuijten. In re Nuijten, 84 USPQ2d 1495 (Fed. Cir. 2007) and In re Nuijten, 85 USPQ2d 1927 (Fed. Cir. 2008).

Paragraph [0014] states:

A "computer-readable medium" refers to any storage device used for storing data accessible by a computer. Examples of a computer-readable medium include: a magnetic hard disk; a floppy disk; an optical disk, like a CD-ROM or a DVD; a magnetic tape; a memory chip; and a carrier wave used to carry computer-readable electronic data, such as those used in transmitting and receiving e-mail or in accessing a network.

Additionally the computer-readable medium does not add to claim 1 a physical transformation or a specific machine.

Claim 27:

This claim broadens parent claim 1 whose method did not claim a physical transformation or specific machine to cover every means for performing the claimed functions, thus, claim 27 does not claim a physical transformation or specific machine.

In re Bilski discusses In re Ablel and in view of Abele the apparatus or computer of the claims does not make the method statutory since at page 688 of Abele an apparatus claim 7 was held non-statutory for the same reason given for method claim 5.

Claim 28:

This claim broadens parent claim 4 to cover every means for performing the claimed functions, for the same reasons given above for claim 27, thus, claim 28 does not claim a physical transformation or specific machine. Additionally the external processor does not add a physical transformation or a specific machine to the claim since its processing is abstract.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Video processing apparatus is not defined by the specification, thus, this newly claimed limitation is not conveyed by applicants specification.



11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-38

The meaning of video processing apparatus is unclear as to the type of apparatus and in view of claims 26-28 may mean something different than the meaning normally given to video processing apparatus.

Claims 26-28:

These claims claim a computer performs the method of claim 1 which method includes a video processing apparatus, thus, these claims are unclear which of the computer or video processing apparatus performs the method.

### ***Double Patenting***

13. Claims 31 and 32 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 4 and 6. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shozo Abe, JP-58132854, teaches extracting previously written additional information from a picture.

PURPOSE: To handle picture data considerably easily, by writing the additional information within a picture, therefore understanding easily the contents of the picture just by extracting the picture.

Rhoads et al, US Patent No. 6,988,202, teaches a two step process used to extract watermarks.

15. An analysis of the claimed invention with regard to the prior art will be held in abeyance until the claimed invention has been clarified since the metes and bounds of the claims are not definite and since the specification does not support the claims. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859,134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions). US Patent and Trademark Office Appeal No. 2008-0580, Ex Parte Bobroski, decided March 31, 2008.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu

can be reached at (571) 272-7661. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/  
Primary Examiner, Division 2628